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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|---------------------------|---------------------|------------------|
| 10/572,738   | 03/21/2006  | Hironori Sato             | U 016209-8          | 6917             |
| 140  | 7590        | 02/04/2010                | EXAMINER            |                  |
| LADAS & PARRY LLP<br>26 WEST 61ST STREET<br>NEW YORK, NY 10023 |             | FAISON GEE, VERONICA FAYE |                     |                  |
|  |             | ART UNIT                  |                     | PAPER NUMBER     |
|  |             | 1793                      |                     |                  |
|  |             | NOTIFICATION DATE         |                     | DELIVERY MODE    |
|  |             | 02/04/2010                |                     | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/572,738             | SATO ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | VERONICA FAISON GEE    | 1793                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 October 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3,5,6,8 and 10-33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,5,6,8 and 10-33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Response to Amendment/Arguments***

Claims 1, 5, 6, 10, 11, 18-21 and 31-33 have been amended, no claims have been added and claims 2, 4, 7 and 9 have been canceled. Hence, claims 1, 3, 5, 6, 8 and 10-33 are pending in the application.

Applicant's arguments are persuasive to the extent that previous rejections have been withdrawn. However a new grounds of rejection has been made in view of the claims as amended in view of newly discovered art Miyabayashi (US 2003/00029355).

### ***Claim Objections***

1. Claim 6 is objected to because of the following informalities: Claim 6 recites "prigments" the Examiner believe that this is a misspelling and should be --pigment--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3, 5, 6, 8 and 10-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi (US 2003/00029355).

Miyabayashi teach ink set comprising a plurality of ink compositions each containing at least a colorant, a water-soluble organic solvent, and water (abstract, 0022, 0183). The reference further teaches that the colorant may be carbon black for black ink, Pigment Yellow 74 for yellow ink, Pigment Blue 15:3 for cyan ink and Pigment Violent 19 and 32 for magenta ink (0185, 0186, 200) present in the amount of 0.1 to 25% by weight. When the pigment or water-sparingly-soluble dye is used as the colorant it is preferred to add a dispersant (0244) that may be present in the amount of about 1 to 50% by weight of the colorant (0248). The water-soluble organic solvent (organic solvent with a high boiling point) may be glycerin present in the amount of 0.01 to 20% by weight (0256). A surfactant may be present in the amount of 0.01 to 10% by weight (0260). The reference discloses that a penetrant (permeation enhancer) may also be present in the composition in the amount of 0 to 20% by weight (0265). The ink set may be used in a image recording method to form a stable image (0309). The ink set was tested by loading the ink into a ink cartridge of Ink Jet Printer PM700C and then printed on paper (0349).

Miyabayashi fails to specifically exemplify the use of Pigment Violet 32 as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the Pigment Violet 32 as claimed by applicant as Miyabayashi also discloses the use of Pigment Violet 32 but shows no example incorporating them.

Miyabayashi and the claims differ in that Miyabayashi does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Miyabayashi overlap the instantly claimed proportions and therefore are considered to establish a *prima facie* case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose... [T]he idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 626 F. 2d 846, 850, 250 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

### ***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/  
Supervisory Patent Examiner, Art Unit 1793

/Veronica Faison-Gee/  
Examiner, Art Unit 1793